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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,815	01/30/2001	Patrick S.L. Wong	ARC 2958R1	1011

7590

06/02/2003

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EXAMINER

REDDICK, MARIE L

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 06/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

H.G

Office Action Summary

Application No.

09/772,815

Applicant(s)

WONG ET AL.

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-14 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-14 and 16-19 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. *The following is a quotation of the second paragraph of 35 U.S.C. 112:*

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. *Claims 9-14 and 16-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

A) *The recited "polymer selected from a group consisting of" per claim 9 constitutes indefinite subject matter as per said phrase engendering an inconsistency with proper Markush terminology. Use of "polymer selected from the group consisting of" is suggested, consistent with proper Markush practice.*

B) *The recited solvent concentration per claims 11 and 12 constitutes indefinite subject matter as per it not being readily ascertainable as to the entity that said contents are being based on, i.e., total composition or else.*

C) *The recited "wherein the polymer concentration in the solvent" per claims 13 and 14 constitutes indefinite subject matter as per a) said phrase engenders an ambiguity and b) it is not readily ascertainable as to whether the concentration is based on "polymer + solvent", "total coating composition" or other.*

Specification

3. *The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.*

Claim Objections

4. *Claim 9 is objected to because of the following informalities: In claim 9 @ lines 2 and 5, "a" should be inserted before "polymer" and "solvent", respectively so as to engender claim language clarity.. Appropriate correction is required.*

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 9-14 and 16-19 stand rejected under 35 U.S.C. 102(b or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Blose et al(U.S. 3,663,278), *Depoorter(U.S. 3,853,563), Hochberg et al(U.S. 3,929,693), Matsumoto et al(U.S. 4,256,492), Cope(U.S. 4,638,022), Whitbourne(U.S. 5,331,027), Socci et al(U.S. 5,977,217) or Schwark et al(U.S. 6,429,248 B2).

Blose et al disclose solvented coating compositions defined basically as containing about 3-40 wt.% of a cellulosic polymer such as cellulose acetate butyrate, about 15-70 wt.% of a thermoplastic resin, about 3-40 wt.% of a plasticizer, about 1-45 wt.% of a sensible material such as dyes and other conventional adjuncts such as pigments, waxes, organic carrier solvents such as methyl and ethyl alcohol, ketones such as acetone, etc. See, the Abstract, cols. 2, 3, 6-9 and Run 2 of Blose et al.

Depoorter et al disclose antihalation coating compositions defined basically as containing a polymeric binder, a coating aid such as finely dispersed polymethylmethacrylate particles, solvent combination which includes water, methanol and acetone, and other conventional adjuncts. See the Abstract, cols. 2, 5 and 6 and Run 3 of Depoorter et al.

Hochberg discloses liquid coating compositions defined basically as containing a combination of polymethylmethacrylate + Cellulose Acetate Butyrate, an acetone/water mixture, plasticizers and other conventional adjuncts. See the Abstract, Runs 1-5 and Runs 1 and 2 of Hochberg.

Matsumoto et al disclose colored ink compositions defined basically as containing resins which include ethyl cellulose, cellulose acetate butyrate, etc., colorants and an alcohol/acetone solvent admixture. See the Abstract, cols. 2 and 5, Run 7 and the claims of Matsumoto et al.

Cope discloses coating compositions defined basically as containing resins which include cellulose acetate butyrate, ethyl cellulose, acrylic resins, etc, solvents which include acetone, lower alcohols such as methanol and other conventional adjuncts such as pigments, etc. See the Abstract and cols. 2-8, Runs and claims inclusive, of Cope.

Whitebourne discloses coating compositions defined basically as containing an organic solution of a hydrophilic polymer such as a methacrylate polymer, a stabilizing polymer which includes ethyl cellulose, cellulose acetate butyrate, cellulose acetate propionate, etc., a solvent system which includes ketones, alcohols, water etc., plasticizers, and other conventional adjuncts. See the Abstract, cols. 1-5, Runs 6, 7 and 9 and the claims of Whitebourne et al.

Socci et al disclose nail enamel compositions defined basically as containing at least one primary film-forming polymer which includes cellulose acetate butyrate, ethyl cellulose, methacrylate polymers, etc., at least one film-forming resin, at least one plasticizer, at least one solvent which includes alcohols, ketones, etc. and other conventional adjuncts which include pigments, etc. See the Abstract and cols. 3-6 of Socci et al.

Schwark et al disclose coating compositions defined basically as containing a solution an electrically conductive polymer, an organic solvent which includes ketones such as acetone, alcohols such as methanol and mixtures thereof and less than 12 wt.% of water, film forming binders which include cellulose esters, cellulose ethers, homopolymers of an alkyl methacrylate, etc, and other conventional adjuncts such as lubricants, coating aids, etc. See the Abstract, cols. 10-12, Runs 8 and 10 and the claims of Schwark et al.

Each of patentees supra therefore anticipate the instantly claimed invention with the understanding that the compositional formulations of each of patentees overlaps in scope with the claimed compositional formulation, in both content and character and with the understanding that the water transmission property limitation per claim 9 is qualifying the semipermeable membrane and not the "coating composition" to which the claims are drawn.

Socci et al and Schwark et al are each provided for by virtue of 35 USC 102(e).

Response to Arguments

8. *Applicant's arguments filed 03/11/03 have been fully considered but they are not persuasive.*

Relative to Blose et al, Depoorter et al, Hochberg, Matsumoto et al, Cope, Whitbourne,

Socci et al and Schwark et al— The crux of Counsel's arguments appears to hinge on

none of the references disclose a coating composition that is formed of the constituents recited in the rejected claims and is "adapted to provide a semipermeable membrane".

With all due respect to Counsel's arguments, each one of patentees do, in fact, disclose the coating compositional constituents, as claimed as clearly pointed out in the rejections supra. As to the "adapted to provide a semipermeable membrane", it is not clear as to how this even further limits the claims since the claims are drawn to a coating composition and not an article(semipermeable membrane) and therefore it is not necessary to address this limitation. In any event, Counsel is herein apprised that since it is not clear as to what is being claimed, in the future, a rejection under 35 U.S.C. 112, 2nd paragraph would be made

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with the understanding that a rejection of this nature is not being made at this time as per the prior art outstanding rejections still appear to be valid.

**Counsel is herein further apprised that while Depoorter et al (U.S. 3,853,563) not listed, along with the other prior art, in the "heading" of the rejection of the claims, it is clear that such was an inadvertent omission since the body of the rejection includes Depoorter et al and a description of how the disclosure relates to the claimed invention. Depoorter et al was also listed on the attached FORM PTO 892(10/04/02). An apology is extended to applicants for any inconvenience that this inadvertent oversight may have caused.*

Conclusion

9. *The prior art made of record and not relied upon is cited as of interest in teaching coating compositions overlapping in scope with the claimed coating composition and considered merely cumulative to the prior art supra.*

10. *Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).*

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183. -

Judy M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *JMR*
May 27, 2003